

DETAILED ACTION

Claim Objections

Claim 25 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim.

Claim 24 refers to tension from the weight of the roving and that induced from the fluid as being the only mechanisms applying tension. But dependent claim 25 recites the adjustment of pressure to induce a tension. Since claim 25 adds a further tension, takes the claim to a new, mutually exclusive scope where three mechanisms induce tension. Thus claim 25 does not further limit, rather it changes the scope entirely.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 12-18 and 24 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 12 recites a that the fluid is configured and “further configured”. There is

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no support for a fluid being configured, much less a further configuring. Examiner understands that the fluid is inherently configured to divide the roving (spec. page 8), however there is nothing that suggests applicant had possession of this aspect at the time of the invention. Examiner notes that the scope of "configured to divide" is broader in scope than a step of "dividing". That applicant recites steps of paying out, directing, passing, and throwing, but chooses to not recite "dividing". Examiner finds that "configured to divide" suggests that there need not be actual dividing; "to divide" is an intention or a capability, rather than a required result. Examiner sees nothing in the specification which reasonably suggested applicant considered merely configuring the fluid to be part of the invention. The same applies to the second configuring.

There is no support for the directing being carried out in the absence of tension inducing apparatus or process steps as claimed. For example, one can consider that applicants feature 4 is a "tension inducing apparatus", because it could be used to induce tension. That is, anything could be used to induced tension, for example even a feather could be used to induce a tension. To put it another way: even if the specification suggests having no further induction of tension, there is nothing that reasonably suggests that there is no apparatus whatsoever that could be used to induce tension. More importantly, feature 4 reasonably serves to induce the tension. One would understand that it would inherently have a rolling resistance or the like which would serve to induce/increase the tension (however slight) on the roving.

Still further, there is no support for the "absence" being limited to only the directing. That is, the claim permits tension inducing apparatus/steps during other

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portions of the process, but not during the directing. Thus even if there support for the negative limitation, it does not appear reasonable to limit to only during the directing - such being suggestive of having other tension induction before or after the directing. Of this there is no support.

MPEP 2173.05(i) Negative Limitations

The current view of the courts is that there is nothing inherently ambiguous or uncertain about a negative limitation. So long as the boundaries of the patent protection sought are set forth definitely, albeit negatively, the claim complies with the requirements of 35 U.S.C. 112, second paragraph. Some older cases were critical of negative limitations because they tended to define the invention in terms of what it was not, rather than pointing out the invention. Thus, the court observed that the limitation "R is an alkenyl radical other than 2-butenyl and 2,4-pentadienyl" was a negative limitation that rendered the claim indefinite because it was an attempt to claim the invention by excluding what the inventors did not invent rather than distinctly and particularly pointing out what they did invent. *In re Schechter*, 205 F.2d 185, 98 USPQ 144 (CCPA 1953).

A claim which recited the limitation "said homopolymer being free from the proteins, soaps, resins, and sugars present in natural Hevea rubber" in order to exclude the characteristics of the prior art product, was considered definite because each recited limitation was definite. *In re Wakefield*, 422 F.2d 897, 899, 904, 164 USPQ 636, 638, 641 (CCPA 1970). In addition, the court found that the negative limitation "incapable of forming a dye with said oxidized developing agent" was definite because the boundaries of the patent protection sought were clear. *In re Barr*, 444 F.2d 588, 170 USPQ 330 (CCPA 1971).

Any negative limitation or exclusionary proviso must have basis in the original disclosure. If alternative elements are positively recited in the specification, they may be explicitly excluded in the claims. See *In re Johnson*, 558 F.2d 1008, 1019, 194 USPQ 187, 196 (CCPA 1977) ("[the] specification, having described the whole, necessarily described the part remaining."). See also *Ex parte Grasselli*, 231 USPQ 393 (Bd. App. 1983), *aff'd* mem., 738 F.2d 453 (Fed. Cir. 1984). The mere absence of a positive recitation is not basis for an exclusion. Any claim containing a negative limitation which does not have basis in the original disclosure should be rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. Note that a lack of literal basis in the specification for a negative limitation may not be sufficient to establish a *prima facie* case for lack of descriptive support. *Ex parte Parks*, 30 USPQ2d 1234, 1236 (Bd. Pat. App. & Inter. 1993). See MPEP § 2163 - § 2163.07(b) for a discussion of the written description requirement of 35 U.S.C. 112, first paragraph.

Claim 24: there is no support for the fluid being configured or for "the only mechanisms applying tension limitation" (see above). Furthermore there is no support

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for tension being mechanisms. Or for the scope of mechanisms". That is, the claim encompass non-mechanisms inducing tension, but there is no support for excluding only mechanisms.

There is no support for tensions which apply tension. That is, the last three lines of claim 24 recite "...wherein the tension...and the tension...are the only mechanisms applying tension...."

Lastly there is no support for any applying of tension (last two line of claim 24). That claims recite both inducing and applying tension, there is a presumption that they are two different things. There is nothing in the specification that applicant invented any tension except that created by induction - none by tension.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 24 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 24 :The language "decreased roving breakage" is a word of degree which is imprecise unless a definition or guideline has been set forth in the specification or the term is otherwise well known in the art. See Seattle Box Co. v. Industrial Crating and Packing, Inc., 731 F.2d 818, 826, 221 USPQ 568, 574 (Fed. Cir. 1984). However, there is no evidence in application (nor is Examiner aware of any evidence) that the words

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"decreased roving breakage"" have any art-recognized meaning. Nor is there any guidance or definition in the specification that would allow one of ordinary skill in the art to understand the meaning of the words "decreased roving breakage". Examiner finds nothing in the specification or claims which would reasonably suggest as to what standard the breakage is compared to - to determine whether it is reduced.

It is unclear what is meant by "mechanisms" at the second to last line of claim 24. As indicated above, the last three lines of claim 24 recite that the two tensions apply tension.

IT is unclear what is meant by "applying" tension.

Claim Rejections - 35 USC § 103

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

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the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 12 and 14-17 and 24-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Droux WO 02/084005 (or Droux 2004/054147) in view of Picone 4345927.

Claims 13 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Droux WO 02/084005 (or Droux 2004/054147) in view of Picone 4345927 as applied to claim 12, and further in view of Miller 6491773.

See the 5/18/2009 rejection as to how the art was previously applied. Although claim 12 has been amended and there is a new claim 24, nothing in the claims server to define over the obvious combination. See the arguments section below as to why Examiner sees nothing that defines over the present claims.

Claim 24 refers to "applying tension". It is deemed that Droux only induces tension. There is a tenet of claim construction that different words used in different

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used in different claims are presumed to have different meanings. *Karlin Tech. Inc. v. Surgical Dynamics, Inc.*, 177 F.3d 968, 971-72, 50 USPQ2d 1465 (Fed. Cir. 1999) (recognizing "the common sense notion that different words or phrases used in separate claims are presumed to indicate that the claims have different meanings and scope."). Thus applying and inducing are presumed to be different things. Thus it is reasonable to conclude that Droux has no application of tension, only induction.

Claim 25 it is inherent that the gas is adjusted from atmospheric - to the pressure necessary to perform the process.

Response to Arguments

Applicant's arguments filed 8/18/2009 have been fully considered but they are not persuasive.

It is argued that Droux fails to disclose that the directing of the roving is carried out in the absence of tension inducing apparatus or process steps.... Examiner disagrees. Droux's directing (at 12) appears to be equivalent to applicants directing (at 4) thus it is reasonable to infer that Droux has the same absence.

Applicant points out that pulling means 7 of Droux induces a tension. This does not appear to be very relevant. Such occurs prior to "directing the roving in a downward vertical direction". Claim 12 only recites that the "directing...is carried out in the absence". Thus the broadest reasonable interpretation of the claim is that there can be other tensions during other steps

There is no argument/indication that claim 24-25 defines over the prior art.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Hoffmann whose telephone number is (571) 272 1191. The examiner can normally be reached on Monday through Friday, 7:00- 3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steve Griffin can be reached on 571-272-1189. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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